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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,353	01/05/2001	Carol Kohn Berning	83875	4976

27752

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04/04/2005

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EXAMINER

NGUYEN, TAN D

ART UNIT PAPER NUMBER

3629

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/755,353	BERNING ET AL.	
	Examiner	Art Unit	
	Tan Dean D. Nguyen	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2005.
 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) ☐ Claim(s) _____ is/are allowed.
 6) ☒ Claim(s) 1-30 is/are rejected.
 7) ☐ Claim(s) _____ is/are objected to.
 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant must not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The amendment filed 1/18/2005 has been entered.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-19 (method) are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

In order for the claimed invention to be statutory subject matter, the claimed invention must fall within one of the statutory classes of invention as set forth in § 101 (i.e. a process, machine, manufacture, or composition of matter).

In the present case, claims 1-19 directed to "A method of conducting consumer product research", which is not within one of the classes of invention set forth in § 101.

The "method of conducting consumer product research" comprising the steps of:

- (a) configuring a mock environment ...;
- (b) placing at least one consumer ... ; and
- (c) collecting information during testing of said product", are merely an abstract ideas and do not produce a useful, tangible, concrete results.

The "method of conducting consumer product research" comprising the steps of

- (a) – (c) as shown are:

- 1) merely an abstract idea and

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2) does not reduce to a practical application in the technological arts (integration and manipulation with computer/ computer network to produce an output result) and are therefore are found to be non-statutory.

See *In re Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557, or *In re Waldbaum*, 173 USPQ 430 (CCPA 1972) or *In re Musgrave*, 167 USPQ 280 (CCPA 1970) and *In re Johnston*, 183 USPQ 172.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-4, 6-8, 12-16, 19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Article 3/99 "New uses ... Old Brands" by Wansink et al (hereinafter referred to as "WANSINK et al").**

As for Independent method claim 1, WANSINK et al discloses a method for conducting consumer product research, comprising the following steps:

(a) configuring a mock environment (or simulated environment in the form of a "laboratory home") so as to test a product (see page 3, "everyday amenities, i.e. Arm & Hammer Baking Soda") in a desired context (see page 4, 1st–3rd paragraphs, "using brands in similar ways but in different contexts", or "in similar contexts", or "used in that usage context");

(b) placing at least one consumer within the mock environment for testing said product; and

(c) collecting information during testing of the product.
(see page 3, 2nd paragraph of the Article). Alternatively, the selection of any well known context parameter, i.e. desired context, is within the skilled artisan and would have been obvious if desired. Also, the testing in any desired context the testing of other similar product in other similar desired contest would have been obvious as mere using similar product in similar environment to obtain similar results.

Note that WANSINK et al discloses that this is a better alternative to the "In-home testing" which is disclosed on page 2 of the specification due to the some similar disadvantages. Therefore, WANSINK et al provides a solution similar to the claimed invention. As for the minor difference in the type of product or service testing, this is not critical since the real issue is creating a "laboratory home" wherein a mock or simulated environment is created. The "laboratory home" of WANSINK et al can be used for testing any product in any desired contest since the claim is broad "a method of conducting consumer product research".

As for dep. Claim 2 (of 1 above), which relates to a well known mock environment parameter, the type of mock environment, i.e. # of areas in a simulated house, this is taught in par. 2 "lab home that has living areas, kitchen and bathroom".

As for dep. Claim 3 (of 1 above) which further limits (b) to within an "area", this is taught in page 3, 2nd par. "consumer tour ... lab home that has living areas, kitchen and bathroom".

As for dep. Claim 4 (of 1 above) which deals with the time or when to collect the information, this is taught in WANSINK et al, page 3, 2nd par. Alternatively, the selection of the time for collecting information is within the skilled artisan as routine experimentations to select the appropriate time which normally cover the completion of the testing to get complete information.

As for dep. Claim 6 (of 1 above) which deals the analyzing of information, this is taught in page 3, 2nd par.

As for dep. Claims 7-8 (of 1 above) which deals with the types of information, these are discussed on pages 2-3 of WANSINK et al. Alternatively, these are well known issues relating to conducting consumer product research as shown on the background of the invention, pages 1-2, and would have been obvious to an artisan to apply these concepts.

As for dep. Claim 13 (of 1/7 above) which deals with well known parameter of recording consumer feedback or the type of recording, this is mentioned in page 3, 1st and 2nd paragraphs, i.e. "videotapes". The use of audiovisual recording in any other

place include in mock environment would have been obvious to obtain complete consumer feedbacks which includes images and data.

As for dep. Claim 19 (of 1/7 above) which deals with the testing of plurality of products, a well known product testing parameter, these are shown on page 6 with "Baking soda", "Vinegar", and "chewing gum".

As for dep. Claim 12 (of 1 above) which deals with a well known mock environment configuring parameter, this is shown in page 3, 2nd paragraph by the use of a kitchen or bathroom for the respective product.

As for dep. Claims 14-15 (of 1 above), these are taught in page 3, 2nd paragraph "Food and Brand Lab at the University of Illinois" and carrying out the research for various consumer products.

As for dep. Claim 16 (of 1 above), this is mentioned on page 2, 1st paragraph, "Advertising agencies", or also shown on page 5, last paragraph, "FoodandBrandLab.com". Alternatively, the setting up of the mock environment by any other establishment such as commercial would have been obvious for desired purpose to meet the commercial need.

6. Dependent Claims 5, 9-11, 17-18 (of Independent claim 1 above) are rejected under 35 U.S.C. 103(a) as being unpatentable over WANSINK et al.

As for dep. Claim 5 (of 1 above), the transmitting of the information during testing by other well known means such as broadcasting would have been obvious in view of the general teachings of various means, in-home interviews, write-in, phone

surveys, etc. on page 2, to provide immediate feedback information to companies if immediate response is desired.

As for dep. Claim 9 (of 1 above) which discloses the well known step of screening a pool of candidates to become a testing consumer, this is well known survey parameter, and would have been obvious to do so to improve survey results which is matching the real user to the real product and real environment.

As for dep. Claims 10-11 (of 1 above) which further matching the mock environment to the consumer, this is fairly taught in page 3, 2nd paragraph which general teaches the concept of matching the real user to the real product and real environment.

As for dep. Claims 17-18 (of 1 above), the selection of other type of product besides material such as service or a form of communication are considered as consumer product parameters and would have been to a skilled artisan as mere selection other similar product to obtain similar results since the kernel of the claimed invention is selection of a mock or simulated environment in the form of "laboratory home" so as to test any type product.

Alternatively, the selection of various parameters of conducting a consumer product research or testing is considered as optimizing operating conditions or result effective variables/parameters and the optimizing of result effective variables (or parameters) are considered as routine experimentation to determine optimum or economically feasible conditions and would have been obvious to the skilled artisan, absent evidence of unexpected results. There are no evidence of unexpected results

shown in the specification on any of these variables/parameters. In re Aller, 105 USPQ 233.

7. Claims 20-30 (apparatus) are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Article 3/99 "New uses ... Old Brands" by Wansink et al.

As for Independent apparatus claim 20, WANSINK et al discloses a facility for conducting consumer product research, comprising:

(a) at least one mock environment (or simulated environment in the form of a "laboratory home") so as to test a product (see page 3, "everyday amenities, i.e. Arm & Hammer Baking Soda") in a desired context (see page 4, 1st–3rd paragraphs, "using brands in similar ways but in different contexts", or "in similar contexts", or "used in that usage context");

(b) at least one device for collecting information during testing of the product (see page 3, 2nd paragraph of the Article).

Alternatively, the selection of any well known context parameter, i.e. desired context, is within the skilled artisan and would have been obvious if desired. Also, the testing in any desired context the testing of other similar product in other similar desired contest would have been obvious as mere using similar product in similar environment to obtain similar results.

As for dep. Claim 21 (of 20 above), it has the same limitation as in claim 2 and therefore is rejected for the same reason set forth in claim 2 above to avoid redundancy.

As for dep. Claim 22 (of 20 above), it has the same limitation as in claim 16 and therefore is rejected for the same reason set forth in claim 16 above to avoid redundancy.

As for dep. Claims 23-25, these are inherently included in WANSINK et al in view of the teaching on page 3, 2nd paragraph wherein the information are further analyzed, ideas are then moved to other groups and surveys.

As for dep. Claims 26-27, these are taught in page 3, 2nd paragraph, page 4, and pages 6-8 (*) wherein different products, different purposes and events which require different settings or areas or rooms, focus groups and panels, are mentioned.

As for dep. Claims 28-30, these are taught in page 3, 2nd paragraph, page 4, and pages 6-8 (*) wherein different products, different purposes and events which require different settings or areas, focus groups and panels, are mentioned.

Note that WANSINK et al discloses that this is a better alternative to the "in-home testing" which is disclosed on page 2 of the specification due to the some similar disadvantages. Therefore, WANSINK et al provides a solution similar to the claimed invention. As for the minor difference in the type of product or service testing, this is not critical since the real issue is creating a "laboratory home" wherein a mock or simulated environment is created. The "laboratory home" of WANSINK et al can be used for testing any product in any desired contest since the claim is broad "a facility for conducting consumer product research".

Response to Arguments

8. Applicant's arguments (3), see remarks, filed 1/18/2005, with respect to the rejections of claims 1-19, 20-30 under (1) 35 USC 101 and (2) 102 (b)/103 (a) over WANSINK et al have been fully considered and are NOT persuasive.

(1) Applicant's comment with respect to the 101 rejection is noted, however, this is not found persuasive for the same reason set forth in par. No. 2 above.

(2) Applicant's comment with respect to the term "in a desired context" is noted, however, this is taught in WANSINK et al on page 4, 1st–3rd paragraphs, "using brands in similar ways but in different contexts", or "in similar contexts", or "used in that usage context". Alternatively, the selection of any well known context parameter, i.e. desired context, is within the skilled artisan and would have been obvious if desired. Also, the testing in any desired context the testing of other similar product in other similar desired context would have been obvious as mere using similar product in similar environment to obtain similar results.

(3) Applicant's comment with respect to the "well known desired context prior to testing" is not taught in WANSINK et al is noted, or in other word, WANSINK et al deals with "unknown context", this is not found persuasive. First, this explicit phrase of "well known desired context prior to testing" is not in the claim, and secondly, the "desired context" reads over the 3 types of desired contexts listed in the above paragraph.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

No claims are allowed.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (703) 306-5771, or e-mail CustomerService3600@uspto.gov.

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (703) 308-2053 (till April 15, 2005) or (571) 272-6806 (beginning in April 15, 2005). My work schedule is normally Monday through Friday from 7:00 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor John Weiss may be reached at (703) 308-2702. The FAX phone numbers for formal communications concerning this application are (703) 872-9306. My personal Fax is (703) 872-9674. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

dtn
March 21, 2005


DEAN T. NGUYEN
PRIMARY EXAMINER